

Docket No. 4512/80212

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Pharma Mar, s.a. et al.
SERIAL NO. 09/787,461 (not recognized)
FILED: 12 October 2001
FOR: Compositions and Uses of ET743 for Treating Cancer
TOTAL PAGES: 6 (including this cover sheet)
ATTN: Examiner Yvonne R. Abbott
FACSIMILE NO. (703) 308-6916 (Petitions Office - Patent)

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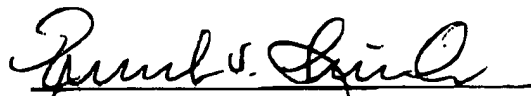
MAR 19 2002

PETITIONS OFFICE

CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that the correspondence attached hereto, namely a Request for Clarification..., was filed by facsimile in the USPTO on the date shown below.

Respectfully submitted,



Ernest V. Linek (29,822)
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Date: 19 March 2002

Document No. 79558

#4

Docket No. 4512/80212

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Response
7-2-02

APPLICANT: Pharma Mar, s.a. et al.
APPLN. NO.: PCT/GB00/01857 (designating the US)
FILED: 15 May 2000
FOR: Compositions and Uses of ET743 for Treating Cancer

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231
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Sir:

PETITIONS OFFICE

**REQUEST FOR CLARIFICATION REGARDING THE DECISION DENYING
APPLICANT'S PETITION FOR RETROACTIVE FOREIGN FILING LICENSE**

Applicant respectfully requests clarification of the attached communication from the Examiner regarding Applicant's petition for retroactive license under 35 U.S.C. §184.

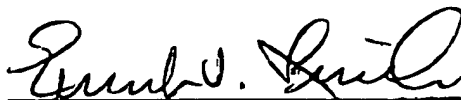
First - the U.S. Serial Number cited in the paper (U.S.S.N. 09/787,461) is not recognized either by the undersigned attorney or by UK counsel for the Applicant - Graham Ruffles.

It is believed that the national phase US Filing of PCT/GB00/01857 has been accorded U.S.S.N. 10/031,810. Clarification is requested.

Second - the mailing date of the paper is illegible. Please confirm the mailing date so that the response may be properly docketed.

Request for Clarification re the Pending
Petition for Retroactive Foreign Filing License
Page 2 of 2

Respectfully submitted,



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Date: 3/19/2002

Document No. 79555



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/787,461	12-Oct-01	PHARMA MAR, S.A. ET AL	4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR
TREATING CANCER

Correspondence Address:

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BOSTON, MA 02109

Art Unit	Paper Number
PATENT & TRADEMARK OFFICE	

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E. V. LINEK

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.

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BANNER & WITCOFF



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

In re: Pharma Mar, s.a. et al. :DECISION ON REQUEST
Serial No.: 09/787461 :UNDER 37 CFR 5.25
Petition Filing date: March 2, 2001
Docket No.: 4512/80212

Title: COMPOSITIONS AND USES OF ET743 FOR TREATING CANCER

This is a decision on the petition filed March 2, 2001 for retroactive foreign filing license.

Decision: Denied

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

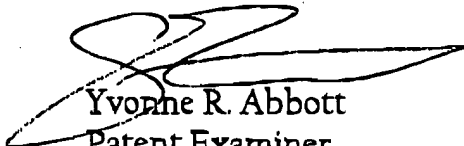
The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(ii) and (iii) have not been met.

There appears to be no error as to why the material was first filed abroad. In the declaration of attorney Graham Ruffles, it states in ¶ 3 that "under UK patent law, there is no requirement to name the inventors". It appears that it was merely reliance on UK law and not lack of knowledge of the requirements of US laws that prevented the legal representatives from conducting a thorough investigation of inventorship. Not determining inventorship until later in the prosecution process

is not within the meaning of "error" as provided in 37 CFR 5.25(a)(3)(iii). A statement clarifying this issue is needed.

Furthermore, with respect to the issue of diligence, there is no explanation as to what the attorney did to pursue discovery of facts, or investigation of inventorship between 5/00 (when the US inventors were known) and the filing of the petition on 3/2/01 (almost a year later).

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Yvonne R. Abbott
Patent Examiner
(703) 308-2866

03 308 6916

*** RX REPORT ***

RECEPTION OK

TX/RX NO	5246
CONNECTION TEL	617 227 4399
CONNECTION ID	
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INITIAL SCREENING OF INCOMING PAPERS CHECKLIST

Reviewer: LC Chase

Date: 3-20-02 ⁵ ₃₄₁₂

APPLICATION NO. 091787461

1. PETITION TYPE CODE

☐ R137(a) Petition-----501
☐ R137(a) Petition -----509
 (Issue Fee/Dwgs)
☐ R137(b) Petition-----502
☐ R137(b) Petition-----510
 (Issue Fee/Dwgs)
☐ R137(f) Petition-----536
☐ R182 Petition-----519
☐ R183 Petition-----503
☐ R378(b) Petition-----532
☐ R378(c) Petition-----533
☐ R377 Petition-----521
☐ R3.81(b) Petition-----523
☐ R181 Petition-----515
☐ R181 Petition-----504

PETITION TYPE CODE

☐ R28c Peition-----309
☐ R47 Petition-----313
☐ R53(e) Petition-----408
☐ R53 (R62 filing date)----410
☐ R10 Petition-----411
☐ Lost Application-----412
☐ R78(a)(3) Petition-----535
☐ R78(a)(6) Petition-----535
☐ R55(c) Petition-----535
☐ R314 Petition-----508
☐ R55(a) Petition-----507
☐ Pet. W/D Abn-----525
☐ R705(b)/c-PTA-Bef iss-----550
☐ R705(d) PTA-Aft iss-----551
☐ Other _____

2. LIST PAPERS FILED WITH PETITIONS

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<input type="checkbox"/> Election	<input type="checkbox"/> 129(a) Submsn	<input type="checkbox"/> Revocation/Poa
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<input type="checkbox"/> Brief (3)	<input type="checkbox"/> Drawings	<input type="checkbox"/> Oath/Decl. & POA
<input type="checkbox"/> Reply Brief	<input type="checkbox"/> Oath/Decl & POA	<input type="checkbox"/> Rule 312 Amdt
<input type="checkbox"/> Declaration R132	<input type="checkbox"/> Ext Time ()	

Other Papers _____

3. Is paper a petition to withdraw holding of abandonment: yes no
 If so, send paper and/or file to appropriate location (Note: remove any flag set first):

- a. Nonreceipt of action from TC or assertion that reply was timely filed:
 Send paper to TC _____
- b. Nonreceipt of Missing Parts Notice or assertion that reply was timely filed:
 Send paper to DIRECTOR -OIPE --CP2-7D25 (PH: 308-0910)
- c. Assertion of timely payment of issue fee and/or submission of drawings:
 Send petition to Office of Publications: ATTN: Tom Hawkins
- d. Other _____

4. Other: TC 3640

If not handled in Office of Petitions, send paper to appropriate location.

5. Is petition accompanied by assignment papers, fee address, or other paper which needs to be sent to another location? yes no If so, make copy of assignment papers, fee address, or other paper; mail original to proper location and place copy in file with an indication that the original paper(s) has been forwarded to the appropriate location (Assignment Branch; Maintenance Fee Division, etc.)

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